



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,670	01/27/2004	D. Gabriel Frost	150076.401	3029
7590 David D. Miller 1751 NE 91st Street Seattle, WA 98115	04/26/2011		EXAMINER CLOUD, JOIYA M	
		ART UNIT 2444	PAPER NUMBER	
		MAIL DATE 04/26/2011	DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/766,670	FROST ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joiya M. Cloud	2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02/15/2011.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,14,38-42,45,46,51 and 58 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,14,38-42, 45-46,51, and 58 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

This action is responsive to the communication filed 02/15/2011. Claims 1, 14, 38-42, 45-46, 51, and 58 are PENDING. Applicant's arguments have been carefully considered but are not persuasive.

### **Response to Arguments**

A) “Where Rai fails to anticipate the current invention is in terms of roaming where there is no roaming agreement provisioned a-priori.” Further, Rai “does not make any reference to dynamically and automatically creating a roaming relationship on a transient basis (on-the-fly) where one was not previously configured or provisioned.”

As to the above argument A), Examiner respectfully disagrees. Examiner notes that Applicant should submit an argument under the heading “Remarks” pointing out disagreements with the examiner’s contentions. Applicant must also discuss the references applied against the claims (citing claim numbers as referred), explaining how the claims avoid the references or distinguish from them.

Examiner submits in response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., “*dynamically and automatically creating a roaming relationship on a transient basis (on-the-fly) where one was not previously configured or provisioned.*”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments also fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1 and 14** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim exemplary claim 1, use of the word “system” does not inherently mean that the claim is directed to a machine. Only if at least one of the claimed elements of the system is a physical part of a device can the system as claimed constitute part of a device or a combination of devices to be a machine within the meaning of 35 U.S.C. 101.

In the instant case, the claim is drawn towards “at least one first director component...at least one second director component...and a home provider register...” Applicants are advised to amend claim language to include hardware (i.e. a processor and memory) coupled to a “non-transitory storage medium.” Therefore, the rejection under 35 U.S.C. 101 has therefore been maintained.

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant claim has been amended to recite "*at least one port component and first director component combined into a single machine configuration or alternatively one port component as a distinct machine configuration and one first director component as a distinct machine configuration.*" However, the specification provides no mention/support of port components combined into a single machine configuration or distinct machine configuration.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for

patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 14, 38-42, 45-46, 51, and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Rai (**US Patent No. 6,377,982 B2**).

As per claim 1, Rai teaches a system, comprising: at least one port component through which an end user needs to be authenticated and authorized in order to access a network resource via a network provider's network, the port component being able to enforce an access policy and to apply rules of a service provider of the end user during the end user's use of the network provider's network (**col. 16, lines 40-65, where home provider network and foreign network providers communicate with each other providing access policy to roaming users via provider agreements**); at least one first director component communicatively coupled to the port component to provide the access policy to be used in connection with the network provider's grant of access to its network (**col. 20, lines 27-50 and Figure 16, the Directory components coupled to the Home Registration Server connected to the Foreign Registration Server to provide access**); at least one second director component communicatively coupled to the first director component to provide the access policy (**policies for user subscribed options and services, col. 8, lines 54-col. 9, line 20**) to the first director component in connection with the service provider's request for access to the network provider's network on behalf of its end user and in connection with authentication and authorization of the end user (**col. 17, lines 17-45-col. 18, lines 67, col. 26, lines 58-65, col. 20, lines 27-50 and Figure 16**); and a home provider

register (HPR) component communicatively coupled to the first director component to be used by the first director component in connection with determination of a service provider of the end user (**col. 9, lines 23-28, col. 19, lines 60-67 and col. 20, lines 11-18, where the end systems home networks on the home registration server can be determined via the HDD**).

As per claim 14, Rai teaches further comprising at least one of the following network sharing components: a PartnerAccept component that identifies pre-negotiated cross-license terms between the network provider and the service provider; a billing component wherein end-user usage metrics collected by the port component are transmitted to the network provider and the service provider for accounting purposes (**col. 6, lines 33-55, where only at least one of the claim features is required to anticipate the claim, see where Rai discloses billing information sent for accounting purposes**); a Clearinghouse component to coordinate and ensure payment to the network provider from the service provider as a result of allowing access to the end user (**where only at least one of the claim features is required to anticipate the claim, see where Rai discloses billing information sent for accounting purposes**); an AutoAccept component to determine a minimum compensation that a network provider will accept to allow access to its network by end users of the service provider (**where only at least one of the claim features is required to anticipate the claim, see where Rai discloses billing information sent for accounting purposes**); an AutoPay component to determine a maximum compensation that a service provider will pay to allow its users to access a network provider's network (**where only at least one of the claim features is required to anticipate the claim, see where Rai discloses billing information sent for accounting purposes**); a first AutoRefuse component to specify service providers whose end users are banned from accessing a network

provider's network; and a second AutoRefuse component to specify network providers whose networks are banned from use by a service provider's end users (**where only at least one of the claim features is required to anticipate the claim, see where Rai discloses billing information sent for accounting purposes).**

As per claim 38-45, claims 38-45 are substantially the same as claims 1-14 and thus are rejected for similar rational.

As per claim 46, Rai teaches further comprising implementing an all access pass to allow the end user to access any network provider's network subject to billing policies of these network provider, provide that at least one of the AutoRefuse components does not negate a network share between the network provider and the service provider (**col. 6, lines 34-55**).

As per claim 47, Rai teaches further comprising managing access and use of network resources based on group container definitions (**col. 16, lines 40-65**).

As per claim 51, Rai teaches implementing network authorization, access, and use in conjunction with legacy systems; and further comprising implementing different pricing policies for different port components that can be used by the end user to access the network provider's network (**col. 5, lines 455**);

As per claim 58, Rai teaches an article of manufacture, comprising: a non-transitory storage medium having instructions stored thereon to initiate implementation of a new network share agreement between the network provider and the service provider where no prior relationship existed (**col. 20, lines 27-50 and Figure 16, the Directory components coupled to**

**the Home Registration Server connected to the Foreign Registration Server to provide access).**

## CONCLUSION

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joiya Cloud whose telephone number is 571-270-1146. The examiner can normally be reached Monday to Friday from on 7:30am-5:00pm.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joiya Cloud whose telephone number is 571-270-1146. The examiner can normally be reached Monday to Friday from on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-3922.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JMC**  
**Art Unit 2444**                           **April 22, 2011**  
**/Peling A Shaw/**  
**Primary Examiner, Art Unit 2444**